REMARKS

Claims 1, 4, 5 and 7-11 are pending in the present application. In the Office Action of February 13, 2009, claims 1, 4, 5 and 7-11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Pat. No. 5,617,771 (Landrum) in view of US Pat. No. 4,864,903 (Bickford et al.). Applicant hereby addresses the ground of rejection, amends claim 1 for better form and adds claims 12-16.

1. Claims Rejected Under 35 U.S.C. § 103(a) As Being Unpatentable Over Landrum in View of Bickford et al.

A response to a previous Office Action filed October 29, 2008, stated that Landrum does not disclose or suggest any methodology to the effect that the cycle time between the advance and retract strokes of the cylinder will be shortened when the hydraulic torque wrench has reached a set pressure. The response also noted specific phrases in the claims that reflected this point. However, the Office Action of February 13, 2009, noted that these and other features are functional characteristics of the claimed invention. Applicant is aware of the requirement of MPEP 2114 that states "apparatus claims must be structurally distinguishable from the prior art." It should be noted, however, that the proceedings that served as a basis for this statement (*i.e.*, *In re Schreiber*, *In re Swinehart*, etc.) were largely discussed in the context of inherency of prior art references.

As stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228, "where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." The functional limitations of claim 1 are not inherent characteristics of either Landrum or Bickford et al. or the combination of them. Landrum teaches that "movement continues until the tool reaches the fully advanced position" during the finish mode (col. 8, lines 4-6). Landrum's tool also reaches the fully advanced position during the automatic advance/retract cycle. Therefore, Landrum's system does not include controls that inherently continue operation after reaching the fully advanced position and does not reduce the duration of alternation between advancement and retraction of the cylinder as called for in claim

1. Similarly, Bickford et al. teaches continued "cycling of the wrench until a preselected torque level is reached, whereupon the supply of pressurized operating fluid to the wrench is discontinued to terminate operation of the wrench." (col. 3, lines 26-30). Therefore, Bickford et al.'s system does not include controls that inherently continue operation after the preselected torque level is reached and does not reduce the duration of alternation between advancement and retraction of the cylinder as called for in claim 1. Instead, the duration of alternation between advancement and retraction in both references is increased infinitely because the supply of the pressurized operating fluid is discontinued by the controls disclosed in both references.

For at least these reasons, Applicant asserts that claim 1 as amended is in condition for allowance. Claims 4, 5 and 7-11 are also in condition for allowance at least due to the chain of dependency.

2. New Claims

Method claims 12-16 are hereby added to the present application. These claims are supported at least by the specification as filed, specifically paragraphs 0028 through 0035 as shown in the specification as published in US Pat. App. Pub. 2007/0214921.

Independent claim 12 is drawn to a method including the step of "providing an audible indication by repeatedly actuating the double acting cylinder...after the fastener has been tightened to the desired torque." (emphasis added). Applicant asserts that the combination of Landrum and Bickford et al. does not disclose such a step because 1) Landrum teaches that once the set pressure (desired torque) is reached, the electric motor that controls the hydraulic pump is shut off (col. 7, lines 49-60); and 2) Bickford et al. teaches continued "cycling of the wrench until a preselected torque level is reached, whereupon the supply of pressurized operating fluid to the wrench is discontinued to terminate operation of the wrench." (col. 3, lines 26-30). Furthermore, claim 12 further calls for providing the audible indication by repeatedly actuating the cylinder over a shorter stroke distance than when tightening the fastener. The combination of Landrum and Bickford et al. clearly does not disclose such an action because their respective systems discontinue the supply of hydraulic pressure after the desired fastener torque is reached. Applicant asserts that claims 13 and 14 are in condition for allowance at least due to the chain of dependency.

Independent claim 15 is similarly drawn to a method including the step of "increasing the frequency at which the double acting cylinder switches between advancement and retraction after a desired torque is applied to the fastener and thereby providing an audible indication that the desired torque has been applied." (emphasis added). Applicant asserts that the combination of Landrum and Bickford et al. does not disclose such a step for the same reasons described above. Applicant also asserts that claim 16 is in condition for allowance at least due to the chain of dependency.

It is respectfully submitted that this amendment places this application into condition for allowance. If the Examiner does not believe it does, a telephone interview is requested prior to the issuance of a final office action so please call the undersigned to schedule one.

No fees are believed due for filing this response, however, please charge any fees that may be due, or credit any overpayment, to Deposit Account No. 17-0055.

Respectfully submitted,

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